

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 9

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte L. MERVYN LONG
and BURTON W. HEAD

Appeal No. 1998-3404
Application 08/600,813¹

ON BRIEF

Before CALVERT, FRANKFORT and CRAWFORD, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 3, 5 through 7, 9 and 11 through 13. Claims 4, 8 and 10, the only other claims remaining in the application, stand objected to and according to the examiner would be allowable if rewritten in independent form

¹ Application for patent filed February 13, 1996

including all of the limitations of the base claim and any intervening claims.

Appellants' invention relates to a handle attachment for use on a reel-type fishing rod. A first embodiment of the handle attachment, referred to by appellants as the preferred embodiment, is seen in Figure 1 of the drawings, while a second embodiment of the handle attachment is seen in Figure 2. A copy of claims 1, 11, 12 and 13 on appeal, as reproduced from appellants' Appendix to the brief, is attached to this decision.

The sole prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Bowen	2,158,104	May 16, 1939
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Claims 1 through 3, 5 through 7, 9 and 11 through 13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bowen.

Claims 11 and 13 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the

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now claimed subject matter.

Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding the rejections, we make reference to the examiner's answer (Paper No. 8, mailed November 26, 1997) for the reasoning in support of the rejections and to appellants' brief (Paper No. 7, filed August 28, 1997) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, this panel of the Board has given careful consideration to appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we find that we must reverse the examiner's rejection of claims 1 through 3, 5 through 7, 9 and 11 through 13 on appeal under 35 U.S.C. § 102(b) because we are unable to clearly understand the claimed subject matter due to language which we find renders the claims indefinite. As for the examiner's rejection of claims 11 and 13 under 35 U.S.C. § 112, first paragraph, based on portions of these claims which we are able to understand, we will reverse this rejection also. Our reasoning for the above determinations follows.

Before addressing an examiner's rejection based on prior art, it is an essential prerequisite that the claimed subject matter be fully understood. Accordingly, we initially direct our attention to appellants' independent claims 1, 11, 12 and 13 in an attempt to derive an understanding of the scope and content thereof.

Each of the claims on appeal is directed to a handle attachment *per se*, wherein the handle attachment is intended to be used with a reel-type fishing rod. Each of the independent claims defines the handle attachment as comprising “a handle,” with the handle being “comprised of an elongated member with two ends.” The elongated member (7 in Fig. 1 and 43 in Fig. 2) is said to be arranged “transverse to the fishing rod, horizontally oriented, and positioned directly above the fishing rod when the fishing rod is being used for fishing.” Each of the claims goes on to set forth “a handle extension” (11 in Fig. 1 and 47 in Fig. 2) which has first and second ends, with the first end thereof being “rigidly attached to the handle.” In addition, each of the claims also sets forth “an attaching device for rigidly attaching the handle attachment to the fishing rod,” and requires that the attaching device be rigidly attached to the second end of the handle extension.

In reviewing the claims on appeal, we note that the claims as drafted are ambiguous and indefinite in that it is unclear whether the “attaching device” which is set forth in each of the independent

claims is part of the claimed “handle attachment” or not. We reach this conclusion because the claims all recite an attaching device “for rigidly attaching the handle attachment to the fishing rod” (emphasis added), thereby providing the clear implication that the attaching device set forth in the claims is not part of the “handle attachment.” We also find the recitation that the handle extension is rigidly attached to “the handle” to be somewhat confusing, since the handle was earlier defined as being “comprised of an elongated member with two ends,” and we have no idea from the claim recitations as to how the handle extension is to be associated with the recited elongated member.

In addition to the foregoing, we also note the open-ended and somewhat ambiguous recitation in claim 1 on appeal regarding

“any attachments to the central region of the elongated member being limited to a single member transverse to the elongated member in order to avoid any unnecessary obstructions to the user’s hand when gripping the elongated member.”

What exactly is meant by “any attachments” and “any unnecessary obstructions to the user’s hand” (emphasis added) is not clear. Moreover, the association between the “any attachments to the elongated member” in the above recitation in claim 1 and the attachment of the handle extension to “the handle” is not clear. Are these the same or different attachments?

Looking specifically to independent claims 11 and 13, in addition to the ambiguities we have noted above, we observe that there is no proper antecedent basis for “the handle attachment structure” set forth in the last clause of each of these claims. If appellants are attempting to set forth that the configuration of the handle attachment defined in claims 11 and 13, respectively, functionally permits the user’s hand “to approach the elongated member in a horizontal plane...” (Claim 11) and “to encircle the elongated member...” (Claim 12), then the claims should be so amended.

Under the provisions of 37 C.F.R. § 1.196(b), we enter the following new ground of rejection against appellants’ claims 1 through 13:

Claims 1 through 13 are rejected under 35 U.S.C. § 112, second paragraph, for the reasons explained above, as being indefinite for failing to particularly point out and distinctly claim that which appellants regard as their invention.

Turning to the examiner's rejection of the appealed claims under 35 U.S.C. § 102(b), we emphasize again that these claims contain unclear language which renders the subject matter thereof indefinite for reasons stated supra as part of our new ground of rejection under 35 U.S.C. 112, second paragraph. Accordingly, we find that it is not possible to apply the prior art relied upon by the

examiner to these claims in deciding the question of anticipation under 35 U.S.C.

§ 102(b) without resorting to considerable speculation and conjecture as to the meaning of the questioned limitations in the claims. This being the case, we are constrained to reverse the examiner's rejection of claims 1 through 3, 5 through 7, 9 and 11 through 13 under 35 U.S.C.

§ 102(b) in light of the holding in In re Steele, 305 F.2d 858, 134 USPQ 292 (CCPA 1962). We hasten to add that this reversal of the examiner's rejection is not based on the merits of the rejection, but on technical grounds relating to the indefiniteness of the appealed claims.²

Regarding the examiner's rejection of claims 11 and 13 under 35 U.S.C. § 112, first paragraph, we find that we are in agreement with appellants' position as expressed on pages 15 and 16 of the brief. We also note that aside from urging that the limitations added to claims 11 and 13 by the amendment filed February 28, 1997 (Paper No. 4) are "not supported by the original disclosure" (answer, page 5), the examiner has not explained why he has reached such a conclusion, nor in any way responded to appellants' position on this issue as set forth on pages 15 and 16 of the brief. Thus, in light of the lack of any convincing statements by the examiner, and since we are generally in agree

² As mere guidance to the examiner and appellants, we again note that the claims of the present application are directed to a "handle attachment" *per se* and not to the combination of a handle attachment and a fishing rod as some of the comments and arguments in the answer and brief would seem to imply. Thus, a complete search of the presently claimed subject matter would appear to require searching outside of Class 43, "Fishing, Trapping and Vermin Destroying." As an example, Class 16, Subclass 110R and Class 81, Subclass 489 would appear to be areas deserving of inquiry.

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with appellants' position on this issue, we will not sustain the examiner's rejection of claims 11 and 13 under 35 U.S.C. § 112, first paragraph.

In summary, both the examiner's rejection of claims 11 and 13 under 35 U.S.C. § 112, first paragraph, and the rejection of claims 1 through 3, 5 through 7, 9 and 11 through 13 under 35 U.S.C. § 102(b) have been reversed. A new rejection of claims 1 through 13 under 35 U.S.C. § 112, second paragraph, has been added pursuant to 37 C.F.R. § 1.196(b).

The decision of the examiner is reversed.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 C.F.R. § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 C.F.R. § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the

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new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

REVERSED, 37 C.F.R. § 1.196(b)

IAN A. CALVERT)	
Administrative Patent Judge)	
)	
)	BOARD OF PATENT
)	APPEALS AND
CHARLES E. FRANKFORT)	INTERFERENCES
Administrative Patent Judge)	
)	
)	
MURRIEL E. CRAWFORD)	
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APPENDIX

1. A handle attachment for a reel-type fishing rod comprising:

a handle, the handle being comprised of an elongated member with two ends, the elongated member being gripped by a user's hand while the user is fishing, the elongated member being transverse to the fishing rod, horizontally oriented, and positioned directly above the fishing rod when the fishing rod is being used for fishing, any attachments to the central region of the elongated member being limited to a single member transverse to the elongated member in order to avoid any unnecessary obstructions to the user's hand when gripping the elongated member;

a handle extension having a first and a second end, the first end being rigidly attached to the handle;

an attaching device for rigidly attaching the handle attachment to the fish rod, the attaching device being rigidly attached to the second end of the handle extension.

11. A handle attachment for a reel-type fishing rod comprising:

a handle, the handle being comprised of an elongated member with two ends, the elongated member being gripped by a user's hand while the user is fishing, the elongated member being transverse to the fishing rod, horizontally oriented, and positioned directly above the fishing rod when the fishing rod is being used for fishing;

a handle extension having a first and a second end, the first end being rigidly attached to the handle;

an attaching device for rigidly attaching the handle attachment to the fishing rod, the attaching device being rigidly attached to the second end of the handle extension;

the handle attachment structure permitting the user's hand to approach the elongated member in a horizontal plane tangent to the surface of the elongated member and grip the elongated member without vertical maneuvering.

12. A handle attachment for a reel-type fishing rod comprising:

a handle, the handle being comprised of an elongated member with two ends, the elongated member being gripped by a user's hand while the user is fishing, the elongated member being transverse to the fishing rod, horizontally oriented, and positioned directly above the fishing rod when the fishing rod is being used for fishing, the elongated member having a curved surface to enable the user to grip the handle for long periods of time without pain or discomfort;

a handle extension having a first and a second end, the first end being rigidly attached to the handle;

an attaching device for rigidly attaching the handle attachment to the fishing rod, the attaching device being rigidly attached to the second end of the handle extension.

13. A handle attachment for a reel-type fishing rod comprising:

a handle, the handle being comprised of an elongated member with two ends, the elongated member being gripped by a user's hand while the user is fishing, the elongated member being transverse to the fishing rod, horizontally oriented, and positioned directly above the fishing rod when the fishing rod is being used for fishing;

a handle extension having a first and a second end, the first end being rigidly attached to the handle;

an attaching device for rigidly attaching the handle attachment to the fishing rod, the attaching device being rigidly attached to the second end of the handle extension;

the handle attachment structure permitting the user's hand to encircle the elongated member with only one pair of the user's fingers being separated by a part of the structure.

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